

Applicants respectfully point out what appears to be a clerical oversight in the grouping of claims in Group VI (claims 68-75) and Group VII (claims 68 and 76). Claims 68-76 describe a method for identifying the presence of a molecule. In one embodiment, the molecule is a polypeptide, and in another embodiment, the molecule is a polynucleotide. Applicants believe that the Examiner intended to restrict claims 68-76 into two groups, *i.e.*, one group for a method to detect a polypeptide, and another group for a method to detect a polynucleotide. However, the groupings appear to be in error, as claim 71 should be part of Group VII, which pertains to polynucleotides, and claims 72-75 should be recited in both groups, as those claims pertain to method steps regardless of the materials used in the method.

Thus, Applicants believe that Group VI should properly contain claims 68-70 and 72-75, with restriction to polypeptide molecules, and Group VII should properly contain claims 68, 71-76, with restriction to polynucleotide molecules. Applicants respectfully request the Examiner to reconsider the assignment of claims 68-76 to Groups VI and VII.

Applicants hereby provisionally elect the invention of Group II (claims 27-42) for prosecution on the merits, with traverse.

Although Applicants have elected Group II which did not have any further restriction requirement, Applicants traverse other aspects of the Examiner's restriction requirement in order to preserve future rights. Applicants strongly disagree with the Examiner's restriction of Group I claims to a single fluorescent protein from claim 4, 5, 8 or 9, and further disagree with the restriction to one polypeptide species from claim 22. In the Office Action, on page 2, bottom paragraph, the Examiner alleges, "Each fluorescent protein containing a different amino acid sequence has different chemical property and produces different effect, thus, is a distinct peptide. Each type of polypeptide of interest has a different function and utility, thus is patentably distinct." Applicants believe that the Examiner's restriction of the Group I claims in this manner is inappropriate for a variety of reasons.

Contrary to the Examiner's statements, all the fluorescent species used in the invention share a common function, i.e., they are all monomeric fluorescent proteins. The Examiner states "Each type of polypeptide of interest has different function and utility . . ." (Office Action, page 2). Other than the fact that the different species have differing amino acid sequences, the Examiner provides no support for the assertion that each fluorescent species has a different

function and utility. Indeed, all the fluorescent proteins recited in claims 2, 4, 5, 8 and 9 share a common function and utility, which is why they all equally find use with the invention. Indeed, as admitted by the Examiner, each of these fluorescent protein species is classified in the same class and subclass (class 530, subclass 350; and class 435, subclass 69.7).

Any perceived burden to the Examiner to do searches, whether real or not, can be reasonably minimized by making an election of species requirement. The pending claims describing the present invention include generic claims that recite "monomer of a fluorescent protein." The generic claims are suitably limited in scope, and define those fluorescent protein species that find use with the invention. Each species recited in claims 2, 4, 5, 8 and 9 contain all the limitations of the generic claim, *i.e.*, each of the species is a monomeric fluorescent protein.

Applicants believe that the additional restriction of the monomeric fluorescent protein species in Group I is inappropriate, and such a proposed restriction would appear to be more consistent with election of species practice. If this restriction requirement were reassessed and made an election of species requirement, the Applicants would elect a single fluorescent species, and that species would be examined only in the event that the broader generic claims are held not to be allowable.

Similarly, Applicants argue that examination of the Markush group of claim 22 would not pose an unreasonable burden for the Examiner if that group of species were treated as an election of species requirement in lieu of a restriction requirement.

The restriction of each fluorescent species used in the invention places an unreasonable financial burden on the Applicant. As explained above, Applicants argue that each of the monomeric fluorescent protein species recited in the claims are functionally related despite having different amino acid sequences. There are no fewer than 14 fluorescent species recited in the claims that find use with the invention. If the restriction imposed by the Examiner were proper, this would require the Applicant to file no fewer than 14 patent applications to cover the polypeptides of the present invention. A similar number of applications would have to be filed to protect the polynucleotides of the invention, if upon entry of the present amendment, the Examiner raises a similar issue with regard to the polynucleotide claims, and still more applications would be necessary to protect methods of the invention. This clearly presents an

unreasonable financial burden in obtaining effective patent protection for the invention described in the present application.

This type of restriction requirement places some Applicants at a disadvantage in protecting their intellectual property, as it is unreasonable to assume that an Applicant with limited financial resources would file so many applications. Thus, in the case where an applicant can not afford the expense of numerous applications, the invention in its entirety is essentially disclosed to the public without proper compensation to the Applicant in the form of the right to exclude others from making, using or selling the invention.

THE AMENDMENT

In the present Amendment, Applicants have cancelled all originally filed claims, *i.e.*, claims 1-87. Applicants have added new claims 88-153, which correspond in subject matter and scope to the claims of elected Group II (claims 27-42). The reason for the cancellation of claims 27-42 and submission of the new claims 88-153 is to supply claims reciting polynucleotides that more completely encompass the various aspects of the invention, as described in the originally filed claims 1-53. The exact correspondence of the new claims and the originally filed claims is shown in the table below:

Cancelled Claim	Corresponding New Claim(s)
27	88-121
28	91
29	128, 129
30	134, 135
31	138-143
32	122, 123
33	124, 125
34	126, 127
35	130, 131
36	132, 133
37	136, 137
38	144, 145
39	148, 149

Cancelled Claim	Corresponding New Claim(s)
40	150, 151
41	152, 153
42	146, 147

New claims 88-121 are directed to polynucleotides which encode the polypeptides that were previously recited in cancelled claims 1-26 and 43-53. Applicants believe that the currently pending claims should not be subject to restriction requirement, as the originally filed claims directed to polynucleotides were not subject to further restriction requirement, and also for the reasons discussed above. However, if the Examiner should believe that the new claims should be subject to restriction or election of species requirements, Applicants encourage the Examiner to contact the Applicants on the phone to make a provisional election of a group or species and expedite the prosecution of the present application.

In summary, Applicants hereby provisionally elect with traverse the claims in Group II (claims 27-42) for prosecution on the merits. Applicants hereby cancel all originally filed claims and provide new claims 88-153 for prosecution in the present application. These new claims are comparable in subject matter and scope to originally filed claims 27-42 of elected Group II, and Applicants believe that these new claims should not be subject to any further restriction requirement. The Examiner is respectfully requested to examine these new claims on the merits. Furthermore, the Examiner is respectfully requested to reconsider the restriction requirement to the Group I claims in view of the arguments provided herein.

By provisionally electing with traverse, providing arguments herein and requesting the Examiner to reconsider the restriction requirement, Applicants hereby preserve their right to Petition from the requirement for restriction under 37 C.F.R. § 1.144.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Appl. No. : 09/866,538
Filed : May 24, 2001

Respectfully submitted,

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Dated: September 20, 2002

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